UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,701	05/31/2000	Claus Assmann	SMI/0003.02	3837

7590	01/14/2004		EXAMINER

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EXAMINER
MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/585,701	ASSMANN, CLAUS
	Examiner	**Art Unit**
	Aravind K Moorthy	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 November 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-35_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-35_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _31 May 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:
   1.☐ Certified copies of the priority documents have been received.
   2.☐ Certified copies of the priority documents have been received in Application No. _____.
   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
   since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
   37 CFR 1.78.

   a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
   reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _4_ .	6) ☐ Other: .

DETAILED ACTION

Specification

1.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract exceeds the 150-word limit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1, 2, 8, 12, 13, 16, 17, 23, 27, 28, 31, 34 and 35 are rejected under 35 U.S.C. 102(e)**

as being anticipated by Davis et al U.S. Patent No. 6,367,009 B1.

As to claims 1, 16 and 31, Davis et al discloses receiving at a message transfer agent

(MTA) a request from a client for establishing a secured connection with the MTA for sending

an e-mail message [column 1, lines 52-55]. Davis et al discloses attempting to authenticate the

client, through use of a certificate [column 11, lines 29-64]. Davis et al discloses that if the

client cannot be authenticated, terminating the method without establishing the secured

connection and without sending the e-mail message. Davis et al discloses that if the client can be

authenticated, establishing the secured connection between the client and the MTA [column 12,

lines 14-39]. Davis et al discloses determining whether the encryption employed for the secured

connection meets a predefined minimum encryption strength. Davis et al discloses that if the

encryption employed does not meet the predefined minimum encryption strength, terminating the

secured connection without sending the e-mail message, whereupon the method terminates.

Davis et al discloses that if the encryption employed does meet the predefined minimum

encryption strength, sending the e-mail message [column 17, lines 9-34].

As to claims 2 and 17, Davis et al discloses that the minimum encryption strength

comprises a particular key length of a symmetric cipher used for encryption [column 3 line 66 to

column 4 line 8].

As to claim 8, Davis et al discloses that the client is remote from said e-mail system

[column 9, lines 24-48].

As to claims 12, 27 and 34, Davis et al discloses that the certificate comprises a signed

public key [column 12, lines 40-58].

As to claims 13, 28 and 35, Davis et al discloses that the certificate comprises an X.509

certificate [column 11, lines 12-28].

As to claim 23, Davis et al discloses that the second MTA is remote from said e-mail

system [column 9, lines 24-48].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 3, 4, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Stille et al U.S. Patent No. 5,878,397.

As to claims 3, 4, 18 and 19, Davis et al does not teach that the step of terminating the

method without establishing the secured connection includes returning a temporary error reply

code. Davis et al does not teach the step of terminating the method without establishing the

secured connection includes returning a permanent error reply code.

Stille et al teaches returning a temporary error reply code. Stille et al teaches returning a

permanent error reply code [column 10, lines 10-17]].

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Davis et al so that the step of terminating the

method without establishing the secured connection would have included returning a temporary

error reply code if the client is still trying to authenticate itself. A permanent error reply code would have been sent if the client could not be authenticated.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Stille et al because it gives the client an opportunity to reauthenticate itself if a temporary error code was given and it prevents denial of service with a permanent error code.

4. **Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Mulligan et al U.S. Patent No. 5,937,161.**

As to claims 5 and 20, Davis et al does not teach that the e-mail message is returned to an original sender for the message if the client cannot be authenticated.

Mulligan et al teaches that the e-mail message is returned to an original sender for the message if the client cannot be authenticated [column 7, lines 21-28].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al so that the e-mail message would have been returned to an original sender for the message if the client could not have been authenticated.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Mulligan et al because it lets the original sender know if the recipient is unavailable or that the destination address no longer exists.

5. Claims 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Landfield et al U.S. Patent No. 5,928,333.

As to claims 6 and 21, Davis et al does not teach that the e-mail message is queued for future sending if the client cannot be authenticated.

Landfield teaches that the e-mail message is queued for future sending if the client cannot be authenticated [column 3, lines 35-44].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al so that the e-mail message was queued for future sending if the client could not have been authenticated.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Landfield et al because it allows for efficient updating and maintenance of electronic mail aliases and allows for efficient proactive management of electronic mail message queues [column 1 line 66 to column 2 line 3].

6. Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Golla et al U.S. Patent No. 6,587,874 B1.

As to claims 7 and 22, Davis et al does not teach the step of determining whether the encryption employed for the secured connection meets a predefined minimum encryption strength employs SASL (Simple Authentication and Security Layer) protocol.

Golla et al teaches SASL (Simple Authentication and Security Layer) protocol and its benefits in a network [column 6, lines 46-65].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al so that the predefined minimum encryption strength was SASL (Simple Authentication and Security Layer) protocol.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Golla et al because it allows for negotiation of the use of a mechanism-specific security layer and if the use of a security layer is agreed upon then the mechanism may also define or negotiate an appropriate encryption key [column 6, lines 46-65].

7. **Claims 9, 24 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Higley U.S. Patent No. 5,790,793.**

As to claims 9, 24 and 32, Davis et al does not teach that the client includes a Mail User Agent.

Higley teaches the use and benefits of a Mail User Agent [column 4, lines 35-45].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al so that the client included a Mail User Agent.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Higley because in conjunction with the Mail Transport Agent, mail is correctly addressed and packaged for transport on a network [column 4, lines 35-45].

8.   **Claims 10, 11, 25, 26, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Dickinson, III et al U.S. Patent No. 6,609,196 B1.**

As to claims 10, 11, 25, 26, 29 and 33, Davis et al does not teach that the Mail User Agent communicates with the e-mail system via SMTP (Simple Mail Transport Protocol). Davis et al does not teach that the MTA comprises a Sendmail-compatible Message Transfer Agent (MTA) and wherein the method is controlled, at least in part, by a configuration file for the Sendmail-compatible MTA. Davis et al does not teach that the first MTA communicates with the second MTA using SMTP.

Dickinson, III et al teaches an email system that uses SMTP and its benefits. Dickinson, III et al teaches that the MTA comprises a Sendmail-compatible Message Transfer Agent (MTA) and wherein the method is controlled, at least in part, by a configuration file for the Sendmail-compatible MTA [column 4, lines 9-29].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al so that the Mail User Agent communicated with the e-mail system via SMTP (Simple Mail Transport Protocol). The MTA would have comprised a Sendmail-compatible Message Transfer Agent (MTA) and wherein the method is controlled, at least in part, by a configuration file for the Sendmail-compatible MTA. The first MTA would have communicated with the second MTA using SMTP.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Dickinson, III et al because

SMTP allows inbound and outbound SMTP connections to be limited from or to specific host

and allows connections to or from specific SMTP hosts to be denied [column 4, lines 41-51].

9. Claims 14, 15 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al U.S. Patent No. 6,367,009 B1 as applied to claim 1 above, and further in view of Heiner U.S. Patent No. 6,112,227.

As to claims 14 and 15, Davis et al does not teach that the step of terminating the method without establishing the secured connection includes rejecting at least some subsequent SMTP commands received from the client. Davis et al does not teach that the rejected SMTP commands are rejected with an error. Davis et al does not teach that the step of terminating the method without establishing the secured connection includes issuing an SMTP QUIT command.

Heiner teaches rejecting at least some subsequent SMTP commands received from the client. Heiner teaches that the rejected SMTP commands are rejected with an error. Heiner suggests issuing an SMTP QUIT command [column 3, lines 8-38].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al so that some of the subsequent SMTP commands received from the clients were rejected if the source client was on the reject list and then rejected with an error. An SMTP QUIT command would have been issued if a user were not authenticated.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Davis et al by the teaching of Heiner because it prevents the delivery of unwanted electronic mail and the method thwarts conventional robotic delivery

programs and includes features that will counteract the anticipated use of more sophisticated

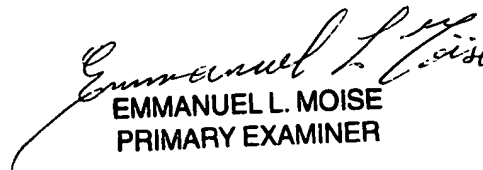robotic delivery systems [column 1, lines 57-64].

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373.

The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz R Sheikh can be reached on 703-305-9648.   The fax phone number for the

organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-1373.

Aravind K Moorthy
December 22, 2003

EMMANUEL L. MOISE
PRIMARY EXAMINER